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EXAMINER				
ARAQUE JR, GERARDO				
ART UNIT		PAPER NUMBER		
3689				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/788,869

Applicant(s)

GOON, BEN NEE

Examiner

Gerardo Araque Jr.

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6-13, 15, 16 and 21-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6-13, 15, 16 and 21-23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 15 – 16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In regards to **claim 15**, the applicant claims, "...receiving at the waiver request database a waiver request form the waiver requestor in response to a test of the product...." However, the Examiner asserts that there has been no positive recitation of testing being done.
4. In regards to **claim 15 – 16**, the Examiner is uncertain as to what the instructions are supposed to do. That is to say, the applicant seems to be claiming various methods and steps that are supposed to be carried out by the instructions, but as discussed below the Examiner asserts that many of the steps appear to be done by a user and all the instructions are really doing is receiving input/data, providing the requested data, and distributing the data based on who the user wants the data to go to. For example, **claim 16** discloses, "...instructions are further configured for: in response to an entry of data via the network by the at least one of the plurality of responders, notifying the waiver requester via the network about a request for additional information." As understood by the Examiner, the instructions are just awaiting an input from a user, after an input has been received transmitting data to another user, and waiting for

additional input from the second user. Essentially, it appears to the Examiner that the instructions are equivalent to a "dummy system" wherein the system does no real processing, but is only present in order to allow communication between users.

Particularly, the Examiner asserts that the applicant has failed to properly disclose what parts of code (instructions) when executed by a computer system would be monitoring a test and, in response to the test, acquire the appropriate documents and provide the documents to a user, for example.

5. In regards to **claim 16**, the Examiner is uncertain what is meant by, "...in response to an entry of data via the network by the at least one of the plurality of responders," notifying the waiver requestor via the network about a request for additional information...." It is unclear as to what kind of data is being inputted into the network that would require for additional information from the waiver requestor. Is there something specific that the responder is requesting from the requestor? Is the responder not providing the waiver until more information about the test is received from the requestor?"

6. In regards the **claim 22**, the Examiner is uncertain as to how the receiving step is to be carried out. **Claim 15** clearly states that the waiver request is received from a waiver requestor. However, **claim 22** states that the waiver request is received from the testing equipment. For the purposes of this examination, the Examiner will assume that after the waiver requestor has used the testing equipment and determined that a waiver request is needed the waiver requestor will then submit information/data so that

the instructions, when executed, will receive the provided information from the waiver requestor.

7. In regards to **claim 23**, the Examiner is uncertain as to how one or more instructions will send the notification from the waiver request database to the responders. Specifically, the Examiner does not understand why the notification will constantly be sent to the responders when they are not needed. That is to say, the instructions are only configured to send information between users when a user has requested information from other users. Once the necessary information has been acquired, why would the instructions continue sending out notifications? Furthermore, the notifications are only to be sent out when they are needed. As a result, how are the instructions sending out notifications when the required information needed by the requestor is not being provided? Essentially, it seems that the responders will eventually be inundated with blank notifications. For the purposes of examination, the Examiner will assume that the instructions are capable of sending additional information to other users.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 15 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Anecki et al (US 2006/0010377) (hereinafter referred to Anecki)** in view of **McKay et al (US 6,418,551) (hereinafter referred to as McKay)**.

10. In regards to **claims 15 and 16**, **Anecki** discloses a computer readable medium for carrying out one or more sequences of instructions for network-based process of a document using a network, the instructions comprising:

providing a legal document database accessible via the network and for storing a plurality of documents and elements corresponding to a product to be tested ([0044], **Figure 1 (1070) Figure 2 (1130)**);

receiving at the database a request from the requester (**Figure 2 (1100) [0048]**);
sending a notification from the database to the plurality of responders (**Figure 2 (1160, 1190) [0009]**); and

transmitting data from the database to the requestor, whereby the requester *may* determine whether the request has been approved by at least one of the plurality of responders (**Figure 2 (1170) (1192), [0007] [0046] [0051] [0053]**).

Anecki does not explicitly disclose that the document is a waiver request.

However, **Anecki** discloses a method for network based document management environment wherein the term “document” is any instrument conveying information.

Thus, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the interactive method of automating the generation of legal documents among multiple requestors and requiring approval of various participants as disclosed in **Anecki** with the ability to make one of

the documents a waiver request since one skilled in the art would recognize a waiver as simply being a legal document providing an express statement, which intentionally and voluntarily gives up something, such as rights, since in many business environments, large numbers of legally binding documents need to be generated, executed, and tracked by participants and many business need to route the documents through a number of different participants and a distributed system as disclosed in **Anecki** provides for the coordination and generation of the documents.

However, **Anecki** does not explicitly disclose that the request is received in response to a test of the product.

However, **McKay** discloses testing a product (**invention relates to design, layout, testing and manufacture of microelectronic circuits, col. 1, lines 13-16**) and waiving one or more design rule violations when running design rule checking operations (**col. 2, line 57 thru col. 3, line 28**).

It would have been obvious to one of ordinary skill in the art to combine the legal document processing method of **Anecki** with the product testing and waiver method disclosed in **McKay** because each violation of a design rule is preferably treated initially as a "suspected" violation prior to comparing one or more waiver layout patterns, wherein at the end of the comprehensive DRC operation, separate files may be generated to list occurrences that have been waived and those that have not been waived, wherein waiving one or more design rule violations may be advantageous in circumstances where a portion of a layout containing a known technical violation is also known to yield acceptable results.

As for the language that “the request seeking a waiver of at least one of the specification elements from at least one of the plurality of responders” and the notification “seeking the requested waiver of the at least one specification element”, the Examiner deems this language to non-functional descriptive data, not functionally related to the steps of the method. Non-functional descriptive data adds little, if anything, to the claimed acts and thus does not serve as a limitation on the claims to distinguish over the prior art. The providing a database step, the receiving a request at the database, the sending a notification, and the transmission of data from the database would be the same, no matter what language is in the request or the notification (See *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

As for the language in **claim 16** which claims wherein the request is for the waiver of at least one test corresponding to the at least one of the specification elements and wherein the instructions are configured for:

in response to an entry of data via the network by the at least one of the plurality of responders, notifying the requestor for additional information;

receiving additional information,

and notifying the plurality of responders about the information

The Examiner asserts the following:

The Examiner deems this language to non-functional descriptive data, not functionally related to the steps of the method. Non-functional descriptive data adds little, if anything, to the claimed acts and thus does not serve as a limitation

on the claims to distinguish over the prior art. The providing a database step, the receiving a request at the database, the sending a notification, and the transmission of data from the database would be the same, no matter what language is in the request or the notification (See *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

11. In regards to **claim 21**, **Anecki** discloses:

wherein the instruction configured for providing is for providing the waiver request to comprise product information comprising at least one of a name of the product, an identification of the product, a category of the product, and a device name, device identification, product category, and a project identification; and

wherein the instruction configured for sending is for sending in response to the product information.

As discussed above, the type of information within the data does not affect how the instructions carry out their functions. The Examiner deems this language to non-functional descriptive data, not functionally related to the steps of the method. Non-functional descriptive data adds little, if anything, to the claimed acts and thus does not serve as a limitation on the claims to distinguish over the prior art. The providing a database step, the receiving a request at the database, the sending a notification, and the transmission of data from the database would be the same, no matter what language is in the request or the notification. Moreover, because the Examiner has already addressed that **Anecki** discloses a method for network based document

management environment wherein the term “document” is any instrument conveying information the information found within the document would not affect how the instructions are to be carried out. Further still, the Examiner asserts that it would have been obvious to one having ordinary skill in the art the when presented with legal documents, including waivers, at least the name or the identification of the product must be present in order to be a valid waiver (See *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

12. In regards to **claim 22, Anecki** discloses wherein the instruction configured for receiving is for receiving the waiver request from testing equipment (**Figure 2 (1100) [0048]**).

13. In regards to **claim 23, Anecki** discloses wherein the one or more sequences of instructions are further configured for periodically sending the notification from the waiver request database to the at least one of the plurality of responders.

As discussed above (as well as in the 112, second paragraph), **Anecki** discloses instructions that are capable of sending information to other users. As a result, the Examiner asserts that it would have been obvious to one having ordinary skill in the art that whenever a user needs information the instructions are fully capable of resubmitting information to other users.

14. **Claims 1 and 6 – 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Anecki et al (US 2006/0010377)** (hereinafter referred to **Anecki**) in view of **McKay**

et al (US 6,418,551) (hereinafter referred to as **McKay**) and further in view of **Dallas Semiconductor with a publication date of 5/30/02** (herein after referred to as **Dallas**).

15. In regards to **claim 1**, **Anecki** discloses a method for processing legal documents over a network connecting a requestor to a plurality of responders relative to a specification having a plurality of elements, method comprising:

providing in the network a legal document database for storing a plurality of documents ([0044]; **Figure 1 (1070)**; **Figure 2 (1130)**);

receiving at the document request database a request from the requestor (**Figure 2 (1100) [0048]**);

sending a notification from the database to the plurality of responders (**Figure 2 (1160, 1190) [0009]**); and

transmitting data from the database to the requestor (**Figure 2 (1170) (1192) [0007] [0051] [0053]**).

Anecki does not disclose:

testing a product;

initiating and transmitting a request requesting a waiver if a tested product fails an element of the specification; or

shipping the device if the plurality of responders approve the document.

However, **McKay** discloses testing a product (**invention relates to design, layout, testing and manufacture of microelectronic circuits, col. 1, lines 13-16**) and waiving one or more design rule violations when running design rule checking operations (**col. 2, line 57 thru col. 3, line 28**).

It would have been obvious to one of ordinary skill in the art to combine the legal document processing method of **Anecki** with the product testing and waiver method disclosed in **McKay** because each violation of a design rule is preferably treated initially as a “suspected” violation prior to comparing one or more waiver layout patterns, wherein at the end of the comprehensive DRC operation, separate files may be generated to list occurrences that have been waived and those that have not been waived, wherein waiving one or more design rule violations may be advantageous in circumstances where a portion of a layout containing a known technical violation is also known to yield acceptable results.

Dallas discloses wherein appropriate people must approve of changes to controlled documents (**page 8**) and that shipping personnel shall prepare all shipping documentation for review wherein no product shipment shall leave the warehouse until it passes inspection by quality control (**page 22**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into legal document processing method of **Anecki** the shipping control taught in **Dallas** because customers require quality and quality improves profitability.

16. In regards to **claims 6 and 8 – 9**, **Anecki** does not disclose receiving at least one response to the notification from the plurality of responders or receiving a second response from the plurality of responders wherein the response is approval of the request, rejection of the request, request for additional information or requesting a hold on the request.

However, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the document exchange disclosed in **Anecki** the ability to process multiple requests.

Moreover, the data in the response is non-functional descriptive data. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the information in the responses adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims

to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the information in the responses does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

17. In regards to **claim 7**, the Examiner notes that the limitation states that if the at least one response is a request for additional information;

notifying the requestor via the network about the additional information;
receiving additional information from the requestor via the network; and
notifying the plurality of responders about the additional information via the network.

The Examiner directs the applicant to MPEP 2106 wherein it states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

18. In regards to **claim 10, McKay** discloses generating a database entry corresponding to each request (**col. 3, lines 11-28**).
19. In regards to **claim 11, Anecki** discloses wherein the database is a distributed database comprising one or more database servers (**Figure 1**).
20. In regards to **claim 12, Anecki** discloses wherein sending the notification comprises sending one of an e-mail, instant text message, or prerecorded voice message (**[0009], [0037], [0041-0043]**).
21. In regards to **claim 13, Anecki** discloses repeating the sending of the notification for a certain time period or until a certain number of response are received (**Figure 2 [0009]**).

Response to Arguments

22. Applicant's arguments filed 4/2/08 have been fully considered but they are not persuasive.
23. Applicant's arguments with respect to **claims 15 – 16** have been considered but are moot in view of the new ground(s) of rejection.

Rejection under 35 U.S.C. 103

Regarding the interpretation of the Federal Circuit Cases

24. Regarding *In re Gulack*, the applicant summarizes by stating that, "Thus, it was entirely the information provided by the text that gave rise to patentability and the function of that information was critical in determining if the claims were patentably distinguishable from the prior art. However, the Examiner asserts that the functional relationship to the substrate gives rise to the patentability.

25. Regarding *In re Lowry*, the applicant states that, "Specifically, the court said the data bits have "information about relationships" between other data stored in memory and that the Board (and of course the Examiner) were "not at liberty to ignore such limitations. Moreover, the court noted that the recited data structures "perform a function" and that function was not found in the prior art, so the claims were patentable." However, applicant's current invention makes no such indication. The Examiner asserts that there are no structural relationships being established and the type of data being used does not affect how the overall structure functions. That is to say, the type of data does not affect how the structure communicates and processes the data. As discussed in the 35 U.S.C. 112, second paragraph, rejection the applicant has failed to disclose what parts of code (instructions) when executed by a computer system would be monitoring a test and, in response to the test, acquire the appropriate documents and provide the documents to a user, for example, and only shows data that is being stored in a database and retrieved when the user requests for it manually, i.e. the program does not make any decisions on when to provided the required information.

Claims 1 and 6 – 13

26. Applicant argues that **McKay** fails to disclose testing a **product** and shipping that **product**. The applicant continues to argue that, "...as known in the art, 'design rule violation' as cited by the Examiner relates to testing a product **design**, not the actual product." However, the Examiner asserts that testing a product design is the same as testing a product. For example, if a prototype is tested and is found to be successful it is asserted that the prototype is, indeed, the final product and, thus, it is further asserted

that by testing a successful prototype one has tested the product. In response to applicant's argument that **McKay** is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, **Anecki** discloses the processing of legal documents, including waivers (discussed in the rejection above), and **McKay** discloses the use of waivers during the testing of a product.

27. Moreover, neither applicant's Specification nor applicant's arguments present any evidence that modifying **Anecki** with the selected elements of **McKay** was uniquely challenging or difficult for one of ordinary skill in the art. Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the combination of **Anecki** with the teachings of **McKay** to disclose testing a product and providing a waiver after the testing of the product. Because this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

28. Regarding applicant's argument of **McKay** not disclosing shipping the product the Examiner asserts that the applicant has failed to establish why **McKay** fails to show

this limitation. Further still, the Examiner asserts that **McKay** was not used to show this limitation, but that **Dallas** was provided to disclose this limitation.

29. Regarding applicant's argument of, "sending a notification from the waiver request database via the network *to the plurality of responders, seeking the requested waiver*," the Examiner has already addressed this limitation in the rejection above.

Conclusion

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./
Examiner, Art Unit 3689
7/3/08

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689